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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,248	09/17/2003	Michael Adam	51082/TJD/M881	1126
57715	7590	02/23/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			HOFFMAN, MARY C	
P.O. BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			3733	
DATE MAILED: 02/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,248	ADAM, MICHAEL	
	Examiner	Art Unit	
	Mary Hoffman	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 2-10, 18-20, 23, 24, 26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 11-17, 21-22 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

It is noted that comparison of the claims with Figure 8-12 and the specification shows, however, that the elected species of Figure 8-12 does not have multiple clamping members with axial lengths smaller than the smallest axial spacing between two successive transverse bores as required in claim 10. Furthermore, referring to page 10, lines 22-24 in the specification, applicant states "Unlike the previous explained variants, in the third embodiment of the invention shown in Figs. 8-12, a single common clamping member is provided...". Therefore, claim 10 is withdrawn from consideration along with claims 1-9, 18-20, 23-24, and 26-27.

Claim Objections

Claims 1, 11-17, 21, 22, and 25 are objected to because of the following informalities:

In order to clarify for examination purposes:

In claim 1, line 12, "the displacement" should be changed to --a displacement--.

In claim 23, line 2, "bores" should be changed to --bore--.

Appropriate correction is required.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11-16, 22 and 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Sohngen (U.S. Patent No. 6,921,400).

Sohngen discloses embodiments of a bone fixing system comprising a nail (ref. #18), the nail comprising a longitudinal axis (ref. #21), a longitudinal bore defining an inner wall of the nail, and at least one transverse bore (ref. #56), and a screw (ref. #32) which is capable of being guided through a transverse bore formed in the nail, the transverse bore being capable of defining orientation and a position of the screw with respect to the longitudinal axis of the nail. The bone fixing system further comprises a clamping member (ref. #50), which is capable of being introduced into the longitudinal bore and is axially adjustable in the longitudinal bore relative to the nail, with the screw guided through the transverse bore of the nail being capable of being to be clamped between the clamping member and the inner wall of the nail bounding the transverse bore by the displacement of the clamping member. For example, after inserting the screw through both the insert and nail, the two components are capable of being slightly rotated opposite to each other, and this would cause the screw to be clamped between the clamping member and inner wall of the nail. The system includes a

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displacement device capable of affecting a pulling force in the clamping member (col. 4, lines 10-17). The clamping member is capable of being freely movable within the axial direction in the longitudinal bore of the nail. The clamping member comprises a passage capable of receiving a screw aligned with a transverse bore. The displacement device includes a drawing screw (FIG. 7, ref. #65) that cooperates with a thread section of the clamping member (FIG. 7, ref. #57) and is supported at the nail, capable of drawing of the clamping member in the axial direction when actuated. The bone fixation has a plurality of screws. At least one transverse bore is circular in cross-section (ref. #30). The nail has multiple transverse bores (ref. #30 and 34). The clamping member has a plurality of passages spaced apart from one another in the axial direction (see FIG. 8, ref. #54). and are capable of being aligned with a transverse bore (ref. #34) Sohngen further discloses a bone fixation nail comprising a longitudinal axis (ref. #21), a longitudinal bore (ref. #28), and at least one transverse bore (ref. #30), the at least one transverse bores having an essentially circular cross-section, and the longitudinal bore being capable of receiving a bushing-like or sleeve-like member.

Claims 1 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara (U.S. Patent No. 6,406,477).

Fujiwara discloses embodiments of a bone fixing system comprising a nail (ref. #10), the nail comprising a longitudinal axis, a longitudinal bore defining an inner wall of the nail, and at least one transverse bore (ref. #24), and a screw (ref. #22) which is capable of being guided through a transverse bore formed in

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the nail, the transverse bore being capable of defining orientation and a position of the screw with respect to the longitudinal axis of the nail. The bone fixing system further comprises a clamping member (ref. #46), which is capable of being introduced into the longitudinal bore and is axially adjustable in the longitudinal bore relative to the nail, with the screw guided through the transverse bore of the nail being capable of being to be clamped between the clamping member and the inner wall of the nail bounding the transverse bore by the displacement of the clamping member. The cross-section of the transverse bore is circular.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sohngen (U.S. Patent No. 6,921,400) in view of Stauch et al (U.S. Patent No. 6,416,516).

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Sohngen teaches the claimed invention except for a securing member, in particular, a securing screw, capable of being moved through a side wall of the nail into its longitudinal bore and fixing the clamping member.

Stauch discloses using a threaded pin (see FIG. 2a) as a securing member which passes radially through the side wall of the nail in order to secure and clamp the inside clamping device, providing a means of securing against removal during operation and to prevent axial movement of the clamping member (ref. #6, col. 3, lines 25-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Sohngen using a threaded pin as a securing member which passes radially through the side wall of the nail in view of of Stauch in order to secure and clamp the inside clamping device, providing a means of securing against removal during operation and to prevent axial movement of the clamping member.

Response to Arguments

Applicant's arguments filed 1/3/2006 have been fully considered but they are not persuasive for the following reasons:

First, applicant argues that the Sohngen patent (U.S. Patent No. 6,921,400) does not have "a clamping member...axially adjustable in the longitudinal bore relative to the nail with the screw guided through the transverse bore of the nail being able to be clamped between the clamping member and the inner wall of the nail bounding the transverse bore by the displacement of the

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clamping member” as required in independent claim 1. Applicant believes that the fastener is not clamped between the clamping member and an inner wall of the nail, but rather, the fastener is clamped against the inner wall of the insert, also referred to as the clamping member. The examiner does not understand applicant’s argument in regard to the fastener can only be considered “clamped between the clamping member and inner wall of the nail” if the clamping member was integral with the nail. Regardless, the Examiner respectfully disagrees with applicant and asserts that the screw is capable of being clamped between the clamping member and the inner wall of the nail bounding the transverse bore by the displacement of the clamping member. For example, as discussed above in the 102(b) rejection, the insert and nail are capable of being slightly rotated opposite to each other, causing the screw to be clamped between the clamping member and inner wall of the nail.

Therefore, the 102(b) rejection of claim 1 and its dependents thereof under Sohngen is deemed proper, as well as the 103(a) rejection over Sohngen in view of Stauch et al (U.S. Patent No. 6,416,516).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER